

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Xiang et al.
Title: SHALLOW TRENCH ISOLATION PROCESS AND STRUCTURE WITH
MINIMIZED STRAINED SILICON CONSUMPTION
Appl. No.: 10/755,602
Filing Date: 01/12/2004
Patent No.: 7,462,549
Grant Date: 12/09/2008
Examiner: Jack S. J. Chen
Art Unit: 2893
Conf. No.: 9549

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 12/09/2008 as U.S. Patent No. 7,462,549.

The Patent Office determined that the patent was entitled to 216 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA

statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicants have recalculated PTA for the captioned patent under the court’s interpretation of the PTA statute, and have determined that the patent is entitled to 427 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 911 days

(b) Total Applicant delay: 484 days

Final PTA Determination: 427 days

Applicants therefore respectfully request that the patent be accorded 427 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date February 6, 2009

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Patent Term Adjustment Calculation System

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Docket Number: 039153-0693
 Application Number: 10/755602
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	01/12/2004	0		
	14 month From Application date	03/12/2005	425		
Edit Delete	Restriction Requirement	09/28/2005	625	200	
Edit Delete	Restriction Requirement Response Received at PTO	10/20/2005	647		
Edit Delete	Notice of Non-Compliance	10/26/2005	653		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	11/03/2005	661		
Edit Delete	Restriction Requirement Response Received at PTO	11/23/2005	681		34
	Restriction Requirement Response Filed + 4 months	03/23/2006	801		
Edit Delete	Non-Final Office Action	04/06/2006	815	14	
	Non-Final Office Action + 3 months	07/06/2006	906		
Edit Delete	Non-Final Office Action	10/18/2006	1,010		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	10/30/2006	1,022		116
	3 Year Period Starts	01/12/2007	1,096		
Edit Delete	Restriction Requirement	02/26/2007	1,141		
Edit Delete	Restriction Requirement Response Received at PTO	03/19/2007	1,162		
	Restriction Requirement Response Filed + 4 months	07/19/2007	1,284		
Edit Delete	IDS under 1.704(c)(8) filed at PTO	10/16/2007	1,373		211
Edit Delete	Restriction Requirement	11/01/2007	1,389	(105)	
Edit Delete	Restriction Requirement Response Received at PTO	11/30/2007	1,418		
Edit Delete	Notice of Allowance	03/25/2008	1,534		
Edit Delete	Issue Fee Paid	06/18/2008	1,619		
Edit Delete	Rule 312 Amendment Received at PTO	06/18/2008	1,619		
	Issue Fee Paid + 4 months	10/18/2008	1,741		
	Rule 312 Amendment Received at PTO + 4 months	10/18/2008	1,741		123
Edit Delete	Response to Rule 312 Communication Received	11/12/2008	1,766		
Edit Delete	Patent Grant Date	12/09/2008	1,793	(697),(52), (52) 697	

Totals:	911	484
PTA:	427	



Version: 3.02.05

LOGIN: Carolyn Simpson

IP: 10.50.33.22

Foley & Lardner LLP